Appl. No. 10/731,673
Amdt. dated December 3, 2008
Reply to Office Action of August 19, 2008

PATENT

REMARKS/ARGUMENTS

The Examiner considers the Amendment submitted November 19, 2008 to be non-compliant as claim 17 had a status identifier of "(Previously Presented)" but had amendments made to the claim.

The undersigned herewith corrects the status identifier of claim 17 to "Currently amended" and hereunder corrects the Remarks/Arguments relating to that claim.

Claims 1-6, 8-15, 17-23, 25, and 26 are pending in this Application.

Claims 1-6, 10-15, 17-22, and 26 are currently amended. Applicants submit that support for the claim amendments and the newly added claims can be found throughout the specification and the drawings.

Claims 1-6, 8-15, 17-23, 25, and 26 remain pending in the Application after entry of this Amendment. No new matter has been entered.

In the Office Action, claims 1-6, 8, 10-15, 17-23, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,136,873 (hereinafter "Smith"), in view of U.S. Patent No. 5,978,475 (hereinafter "Schneier"), in view of U.S. Patent No. 6,584,459 (hereinafter "Chang"), and in further view of U.S. Patent No. 6,647,388 (hereinafter "Numao"). Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith, in view of Schneier, in view of Chang, in view of Numao, and in further view of U.S. Patent No. 7,185,192 (hereinafter "Kahn"). Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Numao.

Claim Rejections Under 35 U.S. C. § 103(a)

Applicants respectfully traverse the rejections to claims 1-6, 8-15, 17-23, 25, and 26 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Smith in view of Schneier, Chang, Numao, and Kahn. The Office Action alleges that claimed invention is directed to obvious subject matter, in that the combination of Smith, Schneier, Chang, Numao, and Kahn expressly or impliedly disclose or suggest the claimed invention. The Office Action further alleges that one of ordinary skill in the art would have found the claimed

invention to have been obvious in light of the teachings of Smith, Schneier, Chang, Numao, and
Kahn.

Applicants, however, respectfully submit that a prima facie case of obviousness
has not been established by the evidence presented in the Office Action. As reiterated by the
Supreme Court in KSR International Co. v. Teleflex Inc. (KSR), 550 U.S. ___, 82 USPQ2d 1385
(2007), the framework for the objective analysis for determining obviousness under 35 U.S.C. §
103 is stated in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). The factual
inquiries enunciated by the Court are as follows:

(A) Determining the scope and content of the prior art;

(B) Ascertaining the differences between the claimed invention and the prior art;
and

(C) Resolving the level of ordinary skill in the pertinent art.

To reach a proper determination under 35 U.S.C. § 103(a), the Examiner must
step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in
the art" when the invention was unknown and just before it was made. In view of all factual
information, the Examiner must then make a determination whether the claimed invention "as a
whole" would have been obvious at that time to that person. (M.P.E.P. § 2142).

Applicants respectfully submit that Smith, Schneier, Chang, Numao, and Kahn,
either individually or in combination, fail to disclose one or more of the claim limitations recited
in each of claims 1-6, 8-15, 17-23, 25, and 26. These differences, along with other difference,
establish that the subject matter as a whole of claims 1-6, 8-15, 17-23, 25, and 26 would not have
been obvious at the time of invention to a person of ordinary skill in the art.

For example, amended claim 26 recites the feature of creating a security rule
having an XML tag within an XML document associated with a first electronic record. (see also
Application: FIGS. 8-13 showing identification of XML tags or XML elements as secure
elements and the creation of security rules using the identified XML tags). As recited in
amended claim 26, a user identified the XML tag as a secure element. Accordingly, as recited in
claim 26, a security protocol can be generated based on the security rule. The security protocol
can protect access to the first electronic record as recited in amended claim 26 based on content

Appl. No. 10/731,673
Amdt. dated December 3, 2008
Reply to Office Action of August 19, 2008

PATENT

within the XML document that corresponds to the XML tag designated as a secure element of the security rule.

For example, as shown in FIG. 12 of the Application, page 130 displays the name of the secure element for which the rule is being created (field 131), the event name (field 132) and allows a user to enter a value in field 133 that, if present in an eRecord, will result in the security condition (grant or restrict) as entered by the user in field 136 being applied to the record. (Application: Paragraph [0092]).

However, Smith, Schneier, Chang, Numao, and Kahn, either individually or in combination, fail to disclose the above-recited features of amended claim 26. In Numao, the access target of "http://admin.trl.com//form//expense.xml" pointed to on page 9 of the Office Action is the actual name of the file and thus, even if stored in the document as alleged, is not the same as an XML tag within an XML document as recited in amended claim 26. The access target is simply the actual name of the file that is used as the Object parameter in Numao, and thus Numao fails to disclose that an XML tag is used as recited in amended claim 26. Accordingly, amended claim 26 is substantially different from the cited references because Numao individually or in combination with the other references fails to disclose that a security rule is created based on an XML tag within an XML document associated with an electronic record that a user has designated as a secure element. Numao fails to disclose protecting access using content within the XML document that corresponds to the XML tag designated as a secure element of the security rule as recited in amended claim 26

Accordingly, Smith, Schneier, Chang, Numao, and Kahn, either individually or in combination, fail to disclose each and every claim limitation recited in amended claim 26 as Smith, Schneier, Chang, and Kahn fail to cure the deficiencies of Numao. This difference, along with other differences recited in amended claim 26, demonstrate that amended clam 26 is allowable over the cited references.

Applicants respectfully submit that independent claims 1, 10, and 18 are allowable for at least a similar rationale as discussed above for the allowability of claim 26, and others.

For example, amended claim 1 recites the feature of generating one or more security rules in response to information from a user identifying a reference to a section of unstructured data within an electronic record as an element of the one or more security rules. As discussed above, Numao fails to disclose that the information in the Object parameter is a reference to a section of unstructured data with an electronic record as recited in amended claim 1. In contrast, Numao simply discloses that the Object parameter is merely the actual name of the document. Numao fails to disclose that any of the other parameters include a reference to a section of unstructured data with an electronic record as recited in amended claim 1.

Applicants respectfully submit that dependent claims 2-6 and 8-9, 11-15 and 17, and 19-24 and 25 that depend directly and/or indirectly from the independent claims 1, 10, and 18 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims. Applicants further respectfully submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

Unless otherwise specified, amendments to the claims are made for the purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof.

While Applicants do not necessarily agree with the prior art rejections set forth in the Office Action, these amendments may be made to expedite issuance of the Application. Applicants reserve the right to pursue claims to subject matter similar to those pending before the present Amendment in co-pending or subsequent applications.

Appl. No. 10/731,673
Amdt. dated December 3, 2008
Reply to Office Action of August 19, 2008

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

/Sean F. Parmenter, Reg. No. 53,437/
Sean F. Parmenter
Reg. No. 53,437

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300
SFP:lls
61716136 v1